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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,268	01/12/2001	Hakaru Matsui	3008-16	9210

7590 03/17/2003

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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

18

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12/23/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4, 15-18, 21, 22, 24-31 is/are pending in the application.  
Of the above claim(s) 25-27 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 15-18, 21, 22, 24, 28-31 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 24, and 28 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 11293365 (PTO-1449, abstract and Figure 1), JP 51045528, JP 11293431, or JP 2000169918.

4. Claims 1, 3, 17-18, 22, 24, and 28 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 05051675.

5. Claims 1-3, 17-18, 21-22, 24, and 28-31 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 57070244 or DD 290501.

6. The cited reference(s) disclose(s) the features including the claimed Cu based alloy composition. The features relied upon described above can be found in the

reference(s) at their abstracts. The difference between the reference(s) and the claims are as follows: cited references do not disclose each alloying element purity level.

However, it is well settled that the difference in degree of purity itself does not predicate invention. In re Merz, 38 USPQ 143 and In re King et al, 43 USPQ 400.

Moreover, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one ordinary skilled in the art would have expected them to have the same properties, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970), and In re Payne 606 F.2d 303, 203 USPQ 245 (CCPA 1979).

To overcome the prima facie case, an applicant must show that there are substantial, actual differences between the properties of the claimed compound and the prior art compound. Hoch, 428 F.2d 1343-44, 166 USPQ 406 at 409.

7. JP 05051675, JP 57070244, and DD 290501 do not disclose the wire diameter. But, as are evinced by JP 51045528, JP 11293431, or JP 2000169918 that the claimed wire size is a conventional high strength wire size. Accordingly, it would have been prima facie obvious for an ordinary skill artisan motivated by a reasonable expectation of success to use the alloys of JP 05051675, JP 57070244, and DD 290501 for wire in order to obtain all of the known benefits. In re Venner, 120 USPQ 193 (CCPA 1958), In re

LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

8. Claims 4 and 15-16 are rejected under 35 U.S.C. § 103 as being unpatentable over references as applied to claims above in view of JP 61113740 and further teaching of JP 02204919.

9. The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for the purities of the copper and other elements and plating the wires. However, JP 6113740 in abstract teaches 5N purity copper is conventionally use for wires in the same field of endeavor or the analogous metallurgical art for improving conductivity. Moreover, it is well settled that the difference in degree of purity itself does not predicate invention. In re Merz, 38 USPQ 143 and In re King et al, 43 USPQ 400. JP.02204919 in abstract disclose that plated wire to improve coil feeding and solderability. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to plate the wire as taught by JP 02204919 in order to improve/provide coil feeding and solderability. In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

#### *Response to Arguments*

10. Applicant's arguments filed December 23, 2002 have been fully considered but they are not persuasive.

11. Applicants' argument with respect to '365, '528, '431, '918, '675, '244, '501, '740, and '919 is noted. But, the instant claims 1-3 do not recite 99.9999% copper purity. Furthermore, the claimed purity of each element is prior forming the claimed wire and claimed purity of each elemental element is not existed in the final product. It is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one ordinary skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, *In re Hoch*, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970), and *In re Payne* 606 F.2d 303, 203 USPQ 245 (CCPA 1979). To overcome the prima facie case, an applicant must show that there are substantial, actual differences between the properties of the claimed compound and the prior art compound. *Hoch*, 428 F.2d 1343-44, 166 USPQ 406 at 409.

12. Applicants argue that alloys of '365 and '918 do not contain In or Mg. But, claims rejected by said references do not contain In or Mg.

13. Applicants' argument in paragraph bridging pages 7-8 of the instant remarks is noted. But, purity of an elemental element is usually reduced if mixed with other elements. Therefore, the purity before mixing with other element would be much higher.

*Conclusion*

14. Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.


*Examiner Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone numbers are (703) 872-9310 (non-final Official Paper only), (703) 872-9311 (after-final Official Paper only), and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
\_\_\_\_\_  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
March 10, 2003